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APPLICATION NO. 08/818,520	FILING DATE 03/14/97	FIRST NAMED INVENTOR FAROUHAR	ATTORNEY DOCKET NO. J P97.0500-R
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EXAMINER

YAO, S

ART UNIT	PAPER NUMBER
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1733

(6)

DATE MAILED:

04/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/818,520

Applicant(s)
Farquhar et al

Examiner
Sam Chuan Yao

Group Art Unit
1733



☒ Responsive to communication(s) filed on Mar 27, 1900

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-6 is/are allowed.

☒ Claim(s) 7-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number for energy director element 22 is missing from the figures.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 09-07-99 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not provide sufficient support for an energy director 22 being in a form of groove as illustrated in the figure.

Specification

3. The amendment filed 03-27-00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "As shown in FIG. 4, the edges of the covers 12 and 14 have a generally u-shaped configuration." (emphasis added). The original disclosure does not provide sufficient support to now broadly state that the edges of the covers have a generally u-shaped configuration.

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Applicant is required to cancel the new matter in the reply to this Office action.

Claim Objections

4. Claims 26-27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Applicant indicated on page 13 that, "In accordance with 35 U.S.C. §112, paragraph 6, this use of means plus function language refers to the structure shown in the specification." If it is Applicant's intention to limit the structure of the PCB package to the one specifically disclosed in the specification and NOT the equivalents thereof, by reciting "means for securing ...", then how do claims 26-27 further limit claim 25?

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 7, the recitation of having at least one finger on each sides in this claim raises an issue of New Matter. The original disclosure teaches providing metal covers having a plurality of fingers, but there is no suggestion in the original disclosure of using a finger for the cover (this claim reads on having a finger on each of 1st and 2nd sides.

In claims 9 and 16, the recitation of having fingers from at least two sides also raises an issue of New Matter. These claims read on having fingers on three or four sides of the metallic cover.

In claim 11, the claim recitation of "with at least one finger extending from each said sides of each cover" raises an issue of New Matter for the same reasons set forth above.

In claim 15, this claim raises an issue of New Matter because the limitation of this claim reads on having a finger on one side of the cover instead of having fingers on each 1st and 2nd sides.

In claim 18, the claim recitation of "U-shape" raises an issue of New Matter. The original disclosure fails to teach providing metal covers having an edge forming a U-shape. It is suggested for Applicant to cite a passage or passages to provide support on the newly claimed subject matter. It is interesting to note that as clearly shown in figure 4, the edge portion of the metal covers are bent toward the base of the metal covers. This figure clearly shows that the edge portion of the metal cover does not form a U-shape edge as now claimed (see the fingers).

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Moreover, broadening the claim by not requiring the metal cover to include fingers extending from each of 1st and 2nd sides of the cover also raises an issue of New Matter.

In claim 21, the claim recitation of "... includes a plastic perimeter surface with a groove recessed below said surface ..." raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

In claims 22-23, the claims recitation of "a finger extends ... the frame element is injection molded partially around the edge" (emphasis added) raise an issue of New Matter. The original disclosure fails to teach the presently claimed subject matter. It is suggested for Applicant to cite passage or passages which provide support to the presently claimed subject matter.

In claim 24, the limitations in this claim reads on having one, three or all edges being bent; and one, three or all sides having fingers. There is no sufficient support in the original disclosure for these embodiments.

In claim 25, the limitations in this claim do not require 1st and 2nd sides having fingers; the edges of the sides being bent; and fingers being embedded in the frames by injection molding process. Moreover, the recitation of "means for securing ..." raises an issue of New Matter. Note: in accordance with 35 U.S.C. §112, paragraph 6, the use of means plus function language is construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. In view of Applicant's recitation of dependent claims 26-27 structurally further limiting the "means for securing ..." (thus implying that the "means for securing ..." is not limited

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to the structure describe in the specification, but could other structures NOT disclosed and considered to be equivalents thereof); and in view that the whole disclosure does not provide sufficient support of having different embodiments that are structurally equivalent to the one disclosed in the specification; this claim raises an issue of New Matter.

In claim 26, the limitation in this claim does not require fingers.

In claim 27, the limitaiton in this claim reads of having one, three or four sides having fingers.

In claim 28, the recitation of the edges being generally U-shape raises a issue of New Matter for the same reasons set forth above.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15, 18-23 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 is indefinite because it is unclear how this claim further limit amended claim 11. Amended claim 11 requires "at least one finger extending from each of said sides". This claim would appear to broaden claim 11 instead of narrowing it.

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Claim 18 is indefinite because the term "generally U-shaped configuration" is not understood. Which portion of the metallic cover is taken to be "generally U-shaped configuration" of the cover?

Claim 25-27 are indefinite because it is unclear what is intended by the phrase "means for securing ...". Applicant indicated on page 13 that, "In accordance with 35 U.S.C. §112, paragraph 6, this use of means plus function language refers to the structure shown in the specification." If applicant intends to specifically limit the "means for securing ..." to the structure specifically taught in the specification and NOT the equivalents thereof, then how do claims 26-27 further limit claim 25? Clarification of this limitation is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 25 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baudouin et al (US 5,208,732).

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Reissue Applications

11. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

12. Claims 7-27 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In an examiner's amendment in S.N. 08/092,102 (the parent of this reissue application), a limitation requiring "each cover having a first side and a second side with a plurality of fingers extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in" (emphasis added) included to claim 1 to place the application in condition for allowance. In addition, in amendment B in Paper No. 6 dated 08-08-99, in response to Examiner's office action, Applicant amended the claim to include "the plastic frame elements being injection molded around a plurality of fingers" (emphasis added), and then argues on pages 3-4 the criticality of injection molding and "protruding metallic fingers" to the invention. These claims do not, however, include the above limitations, and as such are an

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improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

13. The amendment is objected because it fails to provide an explanation of the support in the disclosure for each amendment (non-editorial) with comments on pages separate from pages containing amendments as required by 37 C.F.R. 1.121(b)(2)(iii).

Response to Arguments

14. Applicant's arguments and declaration filed on 03-27-00 have been fully considered but they are not persuasive.

In response to Applicant's argument on pages 6-7 regarding the proposed drawing, Examiner agrees with Applicant that the original disclosure suggests mating energy directors 20 and 22. However, it does not necessarily suggest that the energy director 22 must be a groove. In fact, one in the art could have reasonably understood the energy director 22 to be of the same configuration as energy director 20 shown in figure 2. There is no clear evidence in the original disclosure that would have led one to believe that the energy director 22 is a groove as now shown in the proposed drawing. To add such after filing of the application is new matter.

In response to Applicant's argument on pages 7-9, regarding the written description requirement, one of the tests, the court effectively uses, for determining whether or not something is new matter is a sufficiency of support in the original disclosure. The question that must be

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answered is *"whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter"*, In re Ralston 227 USPQ 177. Here, it appears that Applicant did not have possession at that time of the later claimed subject matter of requiring, for example: "at least one finger", "generally U-shaped configuration", etc.

Contrary to applicant's assertion, amended claim 7 does not obviate the rejections because the limitation of "at least one finger" reads on a finger. As noted above, the original disclosure does not provide sufficient support on the presently claimed subject matter.

In response to Applicant's argument on page 10 regarding the use of transitional phrase "comprising", if Applicant's argument holds true, then one can basically add almost any elements, not disclose, in the original disclosure. For instance, would it then be acceptable (i.e. no New Matter is added) to now require the metal covers to have an embossed surface for decorative purpose or provide a protective gold/platinum plating on the metal coverings because claim 1 uses a transitional phrase "comprising"?

In response to Applicant's argument on page 11 regarding a limitation which requires a "generally U-shaped configuration", contrary to Applicant's assertion, it is submitted that such a limitation is limited to the configuration shown in figure 4. For instance, would covers having the following edges shown below be considered to have a "generally U-shape configuration"?



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If so, is it Applicant's contention that no new matter is introduced if the above configurations are used? If not, why not? Why would the configuration shown in figure 4 (U) is considered to have a "generally U-shape" but not the configurations illustrated above?

In response to Applicant's arguments on page 12 regarding claims 22-23, the edge of a cover that is partially embedded may also prevent the separation of the covers and the frame elements. However, this is not the issue. The issue here, is whether or not the original disclosure provide sufficient support of injection molding around the edge. As clearly shown in figure 4, the bent edge are fully embedded by the frame element.

In response to the submitted declaration, adjunct Professor Wingfield may be an expert in this field. However, Professor Wingfield is not more than a lay person in terms determining whether a subject matter raise an issue of New Matter as stated under 35 U.S.C. 112 1st paragraph. Moreover, it would appear that Professor Wingfield only presented conclusory statements and arguments, but failed to provide a legal basis and objective evidence for his conclusion.

In response to Applicant's argument on page 3 to page 4 paragraph 1 regarding the recapture rule, as correctly noted by Applicant on the bottom of page 3, the previous Examiner added in an Examiner's Amendment "each cover having a first side and a second side. with a plurality of fingers extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in" (emphasis added) to place the application in condition for allowance. Note that in the Examiner's amendment, it requires

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“fingers” as opposed to “finger”; the fingers extending from first and second sides as opposed to “at least two sides”; and the “fingers are embedded in” as opposed to partially embedded or being “injection molded partially around the edge” (emphasis added). Applicant argued on page 16 that “... the bent edges of the metal covers was a limitation that resulted in allowance of the claims over the prior art.” (emphasis added). If that is the case, why did applicant agreed to have the other limitations added to the claim? Is it Applicant’s contention that the previous Examiner would have allowed the application without the other limitations being added to the claim? It is interesting to note that independent claim 25 does not expressly recite covers having bent edges unless the “means for securing ...” is interpreted to be limited to the one disclosed in the specification only. Equally important, in Paper No. 6 dated 08-08-99, in response to Examiner’s office action, Applicant replaced claim 1 with claim 16 to include “the plastic frame elements being injection molded around a plurality of fingers” (emphasis added), and then argues on pages 3-4 the criticality of injection molding and “protruding metallic fingers” (emphasis added) to the invention. Therefore, it is submitted that removing these limitations constitutes an improper recapture of claimed subject matter deliberately cancelled in the application for the patent upon which the present reissue is based.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Sam Chuan Yao** whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Thursday from 8:00 AM-5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mike Ball, can be reached on (703) 308-2058. The **fax number** in Group Art Unit 1733 for any official papers (i.e. papers that will be entered as part of the file wrapper) is (703) 305-7718 and for unofficial papers (e.g. proposed amendments) is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Sam Chuan Yao
Primary Examiner
Art Unit 1733

scy
April 27, 2000